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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,728	06/18/2001	Yoichiro Tomari	1163-0341P	8265

2292 7590 06/10/2005

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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ALABAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,728

Applicant(s)

TOMARI ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is a Non-Final Office Action in response to the Amendment of March 29, 2005.
2. Claims 1-19 are presented for examination following the amendment of March 29, 2005 of which Claims 1, 9, 13, 17 and 18 are Independent.
3. Claims 1-19, are rejected under 35 U.S.C. 103(a).

### ***Priority***

4. Applicant's claim for foreign priority under 35 U.S.C. §119(a)–(d) is acknowledged, the Applicant was accorded the benefit of the earlier filing date of November 10, 1999.

### ***Response to Arguments***

5. Applicant's arguments, see the Amendment filed March 29, 2005, with respect to the rejection(s) of claim(s) 1-19 under 35 USC § 102 have been fully considered and are persuasive. Therefore, the previous rejection of January 01, 2005 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of John R. Nicholson ("Sams Teach Yourself Outlook 98 in 24 Hours" Published in 1998 and Sames hereinafter).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-19, are rejected under 35 U.S.C. 103(a) as being unpatentable by Bryan I-chuen Lee (U.S. Patent No. 6,212,553 and Lee hereinafter) in view of John R. Nicholson ("Sams Teach Yourself Outlook 98 in 24 Hours" Published in 1998 and Sams hereinafter).

Regarding Claims 1, 9 and 13-19 Lee discloses:

an information history list display section for displaying communication history<sup>1</sup> (Figure 14, 35 and 36 and corresponding text) based on history related information (Figures 35 and 36 and corresponding text)<sup>2</sup> which is generated by outgoing or incoming communication (Figures 35 [outgoing] and 36 [incoming] and corresponding text) and indicates the answering state of the respective communication (Figure 36, Elements 3620 and 3610 and corresponding text; see also Figure 14, i.e. status; see also Col 5, Lines 49-56);

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<sup>1</sup> Please note that the Examiner is interpreting the "communication history" to be the same as an "e-mail message". This is according to the Specification of the current application (see page 1, Lines 15-17).

<sup>2</sup> The "history related information" could be interpreted as the e-mails that were sent out the first time to inquire about the Christmas Party.

a server comprising: a personal information management section (address book with personal info) for transmitting, in response to a request, information to said information terminal (Col 17, Lines 24-38).

Lee's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate answering state<sup>3</sup> nor whether the answer has been completed or not, of the respective communication. However Sams teaches answering state (Page 143, Figure 7.4 inbox symbols, i.e. open envelop with a right-pointing arrow (forwarded message); and open envelop with a left-pointing arrow (replied to message) and whether the answer has been completed or not (Page 143, Figure 7.1, i.e. the envelope icons associated with the e-mails (communication) in the inbox.

Given the intended broad application of Lee's system, It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Lee with the teachings of Sams to include this notoriously well-known feature in Microsoft Outlook (e-mail status in the inbox, i.e. unread, read, forwarded or replied ... etc.) as both Lee and Sams are describing communication for Microsoft Corporation; another obvious reason for adding such a feature would be to minimize the users time spent in searching for an e-mail status, to see whether the user did or didn't respond to the e-mail (communication); another reason is to increase the system flexibility by adding a well-known feature that would attract more users due to the increase in the level of the system friendliness (user friendly).

Regarding Claim 2, Lee discloses  
a history management section for recording the communication history (Col 8, Lines 60-64);

and an information management table for recording the history related information (status) that indicates the answering state of the respective communication stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

Regarding Claim 3, Lee discloses wherein said information management table records relationships between the respective communication (e-mail) and said information history list display section (Col 5, Lines 57-64; see also Figure 14 and associated text).

Regarding Claim 4, Lee discloses plurality of different communication means (Figure 1, Element 12 and 13; see also Col 13, Line 49).

Regarding Claim 5, a personal address book for recording a personal name of a communication party (Figure 3, Element 335; see also Col 13, Line 52) and a communication address of the communication party (Col 13, Line 52 ); and an address book search section for searching said personal address book (Col 17, Lines 24-39) wherein said information history list display section displays the personal name in substitution for the communication address included in the history information stored in

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<sup>3</sup> Please note that the Examiner is interpreting the "answering state" according to the Applicant's

said history management section in accordance with a retrieval result from said personal address book by said address book search section (Figure 14 and corresponding text, i.e. the names of the names of the senders under the "From" column displays the personal name, such as, "Bob Winters" in substitution for the communication address (e-mail address)).

Regarding Claim 6, Lee discloses wherein the communication history (e-mails) and the history related information (status) are stored in a server (Col 9, Lines 8-10).

Regarding Claims 7 and 8, the limitations of these claims are similar in scope to the rejected claims 2 and 6, above. They are therefore rejected as set forth above.

Regarding Claims 10-12, Lee discloses:

a history management section for recording communication history (Col 8, Lines 60-64); and

an information management table for recording history related information which indicates the answering state of the respective communication stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

Regarding Claim 17, Lee discloses:

recording communication of respective communication (Col 8, Lines 60-64)

recording history related information and indicates an answering state of the respective communication (Col 5, Lines 57-64; see also Col 23, Lines 16-37)

and displaying the respective communication in connection with the answering state of the respective communication based on the history related information (Figure 14, i.e. status; see also Col 5, Lines 49-56).

### ***Other Prior Art Made of Record***

8. a. Bob Temple ("the Complete Idiot's Guide to Microsoft Outlook 2000", Published 1999, Page 79).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

### ***Points of Contact***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered responses should be brought to the Customer Service Window of the Randolph Building at 401 Dulany Street, Alexandria, VA 22314

*Haythim J. Alaubaidi*

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**

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Patent Examiner  
Technology Center 2100  
Art Unite 2161